

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellants: MADAR, Piero Andreas, et al.
Serial Number: 10/580,997
Atty. Dkt: PU030323
Filing Date: May 26, 2006
For: METHOD AND APPARATUS FOR RESTRICTING PLAYBACK
OF RECORDED DIGITAL SIGNALS
Art Unit: 2431
Examiner: VAUGHAN, Michael R.

APPEAL BRIEF

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Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

In response to the final Office Action dated June 7, 2011 and the Advisory Action dated August 22, 2011, and further to the Notice of Appeal filed on September 7, 2011, Appellants hereby submit an Appeal Brief in accordance with 37 C.F.R. §41.37 for the above-referenced application.

I. Real Party in Interest

The real party in interest is THOMSON Licensing S.A., 46 Quai A. Le Gallo, F-92100 Boulogne-Billancourt, France.

II. Related Appeals and Interferences

There are no prior or pending appeals, interferences, or judicial proceedings known to Appellants, the Appellants' legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. Status of Claims

Claims 1-20 are pending in this application, and are rejected. The rejection of claims 1-20 is being appealed.

IV. Status of Amendments

No amendment subsequent to the final rejection of June 7, 2011 has been filed.

V. Summary of Claimed Subject Matter

Independent claim 1 recites a method (see, for example, flowchart 300 of FIG. 3), comprising steps of:

enabling a user to select a recording title stored on a digital storage medium in a first program chain for password protection (see, for example, page 8, lines 24-27), said first program chain being a single program chain according to DVD specifications (see, for example, page 9, lines 18-21);

receiving a password from said user for said selected recording title (see, for example, page 10, lines 9-16);

storing said password for said selected recording title on said digital storage medium in said first program chain (see, for example, page 9, lines 19-21 and page 10, lines 18-21);

storing a password menu screen for said selected recording title on said digital storage medium in said first program chain (see, for example, page 11, lines 7-8 and

14-15), wherein said password menu screen prompts said user to input said password if playback of said selected recording title is attempted (see, for example, page 11, line 15 to page 12, line 2); and

requiring said password to be input before playing back said selected recording title (see, for example, page 12, lines 4-6).

Independent claim 8 recites a digital recording and playback apparatus (see, for example, element 100 of FIG. 1), comprising:

interface means (see, for example, element 70 of FIG. 1) for interfacing said digital recording and playback apparatus with a digital storage medium (see, for example, page 3, lines 15-16); and

control means (see, for example, element 40 of FIG. 1 and page 5, line 26 to page 6, line 3) for enabling a user to select a recording title stored on said digital storage medium in a first program chain for password protection (see, for example, page 8, lines 24-27), said first program chain being a single program chain according to DVD specifications (see, for example, page 9, lines 18-21), said control means receiving a password from said user for said selected recording title (see, for example, page 10, lines 9-16), causing said password to be stored on said digital storage medium in said first program chain (see, for example, page 9, lines 19-21 and page 10, lines 18-21), causing a password menu screen for said selected recording title to be stored on said digital storage medium in said first program chain (see, for example, page 11, lines 7-8 and 14-15), and requiring said password to be input before playing back said selected recording title (see, for example, page 12, lines 4-6), and wherein said password menu screen prompts said user to input said password if playback of said selected recording title is attempted (see, for example, page 11, line 15 to page 12, line 2).

Independent claim 16 recites a digital storage device (see, for example, element 120 of FIG. 1), comprising:

a plurality of data fields (see, for example, page 3, lines 22-25); and

wherein said data fields comprise a first program chain for storing a selected recording title, a user-assigned password for said selected recording title and a password menu screen for said selected recording title (see, for example, page 9, lines 18-21 and page 11, lines 14-15), said password menu screen prompting said user to input said user-assigned password if playback of said selected recording title is attempted (see, for example, page 11, line 15 to page 12, line 2), said first program chain being a single program chain according to DVD specifications (see, for example, page 9, lines 18-21).

VI. Ground of Rejection to be Reviewed on Appeal

The rejection of claims 1-20 under 35 U.S.C. §103(a) as being unpatentable over Japanese Patent Publication No. 2003-132624 by Tsurui (hereinafter, "Tsurui") in view of U.S. Patent Publication No. 2002/0146238 by Sugahara (hereinafter, "Sugahara"), and further in view of U.S. Patent No. 6,469,718 issued to Setogawa et al. (hereinafter, "Setagawa") is presented for review in this appeal.

VII. Argument

The rejection of claims 1-20 under 35 U.S.C. §103(a) based on the proposed combination of Tsurui, Sugahara and Setagawa should be reversed for at least the following reasons.

Independent claim 1 recites:

"A method, comprising steps of:
enabling a user to select a recording title stored on a digital storage medium in a first program chain for password protection, said first program chain being a single program chain according to DVD specifications;
receiving a password from said user for said selected recording title;
storing said password for said selected recording title on said digital storage medium in said first program chain;
storing a password menu screen for said selected recording title on said digital storage medium in said first program chain, wherein said password menu screen prompts said user to input said password if playback of said selected recording title is attempted; and

requiring said password to be input before playing back said selected recording title.” (emphasis added)

As indicated above, independent claim 1 defines a method having a unique and distinctive combination of features in which: (i) a user-selected recording title, (ii) a user-assigned password for protecting the user-selected recording title and (iii) a password menu screen which prompts the user to input the user-assigned password if playback of the user-selected recording title is attempted, are **all** stored on a digital storage medium in a **single** program chain according to DVD specifications. Independent claims 8 and 16 recite subject matter similar to independent claim 1, albeit in different claim formats.

None of the cited references, whether taken individually or in combination, discloses or suggests, *inter alia*, the desirability of the aforementioned combination of claim features in which: (i) a user-selected recording title, (ii) a user-assigned password for protecting the user-selected recording title and (iii) a password menu screen which prompts the user to input the user-assigned password if playback of the user-selected recording title is attempted, are **all** stored on a digital storage medium in a **single** program chain according to DVD specifications.

The primary reference, Tsurui, discloses a system in which items (i) and (iii) above are each stored on a digital storage medium in **multiple** program chains according to DVD specifications. In particular, Tsurui teaches the use of at least six (6) different program chains to store items (i) and (iii) above (see, for example, drawings 5(b) and (c) and their associated descriptions). In this manner, Tsurui strongly teaches away from the principles of the claimed invention in which items (i)-(iii) above are **all** stored on a digital storage medium in a **single** program chain according to DVD specifications.

The other two references, Sugahara and Setogawa, are unable to remedy the aforementioned deficiencies of Tsurui. Sugahara discloses a system in which items (i) and (ii) above are stored in a single reproduction cell (see, for example, FIG. 8 and its

associated description). Setogawa discloses a system in which a “chapter menu” (which does not correspond to any of the items (i)-(iii) of the claimed invention) is stored in a single program chain. Even assuming, *arguendo*, that the “chapter menu” did somehow correspond to item (iii) of the claimed invention (which it does not), Setogawa clearly teaches that item (iii) should be placed in a single program chain (i.e., PGC 40) **by itself** (see, for example, column 13, lines 1-15). In this manner, Setogawa also **teaches away** from the principles of the claimed invention in which items (i)-(iii) above are **all** stored on a digital storage medium in a **single** program chain according to DVD specifications.

Accordingly, in view of the foregoing discussion, even if the system of Tsurui is modified using the teachings of Sugahara and Setogawa, the resulting modification produces (at best) a system in which items (i) and (ii) are stored in one program chain, and item (iii) is stored **separately** in another program chain.

As such, Appellants submit that none of the cited references, whether taken individually or in combination, discloses or suggests, *inter alia*, the desirability of the aforementioned combination of claim features in which: **(i) a user-selected recording title, (ii) a user-assigned password for protecting the user-selected recording title and (iii) a password menu screen which prompts the user to input the user-assigned password if playback of the user-selected recording title is attempted, are all stored on a digital storage medium in a single program chain according to DVD specifications.** For this reason alone, Appellants submit that the instant rejection should be withdrawn.

Even assuming, *arguendo*, that the proposed combination of references did disclose or suggest each and every feature of the claimed invention (which it does not), Appellants submit that the claimed invention is non-obvious over the proposed combination of references for at least the following additional reasons.

On page 5 of the final Office Action of June 7, 2011, the Examiner alleges:

“After reviewing the claims and the prior art, Examiner finds the notion of using one or more program chains moot. One of ordinary skill in the art could have used or tried any number of program chains to implement a password protected DVD as a matter of common sense.” (emphasis added)

As indicated above, the Examiner ostensibly alleges that one of ordinary skill in the art could have simply arrived at the claimed invention through, for example, a process of trial and error. In other words, the Examiner ostensibly alleges that the cited references could have been modified in a selective manner so as to arrive at the claimed invention.

In response, Appellants submit that the foregoing allegations of the Examiner are not supported by the teachings of the cited references themselves (as explained above), and therefore appear to be the result of impermissible hindsight reconstruction. For example, at least Tsurui and Setogawa teach away from the principles of the claimed invention. Appellants further note that the mere fact that a prior art device could (in hindsight) be modified to produce a claimed invention is not a basis for an obviousness rejection unless the prior art suggests the desirability of such a modification. See, for example, *In re Laskowski*, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989) (“Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to the form the [claimed] structure, ‘[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.’”) and *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

In this case, Appellants submit that none of the cited references, whether taken individually or in combination, discloses or suggests the desirability of the claimed invention in which: (i) a user-selected recording title, (ii) a user-assigned password for protecting the user-selected recording title and (iii) a password menu screen which prompts the user to input the user-assigned password if playback of the user-selected recording title is attempted, are **all** stored on a digital storage medium in a **single** program chain according to DVD specifications.

Rather, as indicated above, at least Tsurui and Setogawa teach away from the principles of the claimed invention. Accordingly, it appears that the Examiner has simply identified isolated features in the prior art, and proposed combining such features in a selective manner in an attempt to meet the requirements of Appellants' claim language. Here, Appellants note that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Accordingly, the mere fact that isolated features of the claimed invention may have been known, independently, in the prior art, and that such features could have been combined is not sufficient to sustain an obviousness rejection.

Therefore, for at least the foregoing reasons, Appellants submit that claims 1-20 are patentable under 35 U.S.C. §103(a) over the proposed combination of Tsurui, Sugahara and Setogawa, and respectfully request the Board to reverse the instant rejection.

Please charge the fee for this Appeal Brief to Deposit Account 07-0832.

Respectfully submitted,

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VIII. Claims Appendix

1. A method, comprising steps of:
 - enabling a user to select a recording title stored on a digital storage medium in a first program chain for password protection, said first program chain being a single program chain according to DVD specifications;
 - receiving a password from said user for said selected recording title;
 - storing said password for said selected recording title on said digital storage medium in said first program chain;
 - storing a password menu screen for said selected recording title on said digital storage medium in said first program chain, wherein said password menu screen prompts said user to input said password if playback of said selected recording title is attempted; and
 - requiring said password to be input before playing back said selected recording title.
2. The method of claim 1, wherein said digital storage medium is a DVD.
3. The method of claim 1, further comprising a step of storing at least one command on said digital storage medium in said first program chain.
4. The method of claim 3, wherein said at least one command causes said password menu screen to be displayed if playback of said selected recording title is attempted.
5. The method of claim 3, wherein said at least one command is created and stored in response to receiving said password from said user.
6. The method of claim 3, wherein said at least one command includes a PRE command according to DVD specifications.

7. The method of claim 1, further comprising a step of-creating said password menu screen in response to receiving said password from said user.

8. A digital recording and playback apparatus, comprising:
interface means for interfacing said digital recording and playback apparatus with a digital storage medium; and

control means for enabling a user to select a recording title stored on said digital storage medium in a first program chain for password protection, said first program chain being a single program chain according to DVD specifications, said control means receiving a password from said user for said selected recording title, causing said password to be stored on said digital storage medium in said first program chain, causing a password menu screen for said selected recording title to be stored on said digital storage medium in said first program chain, and requiring said password to be input before playing back said selected recording title, and wherein said password menu screen prompts said user to input said password if playback of said selected recording title is attempted.

9. The digital recording and playback apparatus of claim 8, wherein said digital storage medium is a DVD.

10. The digital recording and playback apparatus of claim 8, wherein said control means further causes at least one command to be stored on said digital storage medium in said first program chain.

11. The digital recording and playback apparatus of claim 10, wherein said at least one command causes said password menu screen to be displayed if playback of said selected recording title is attempted.

12. The digital recording and playback apparatus of claim 10, wherein said control means creates said at least one command and causes said at least one

command to be stored on said digital storage medium in said first program chain in response to an input from said user defining said password.

13. The digital recording and playback apparatus of claim 10, wherein said at least one command includes a plurality of commands.

14. The digital recording and playback apparatus of claim 13, wherein said plurality of commands comprise PRE commands according to DVD specifications.

15. The digital recording and playback apparatus of claim 11, wherein said control means creates said password menu screen and causes said password menu screen to be stored in said first program chain in response to an input from said user defining said password.

16. A digital storage device, comprising:

a plurality of data fields; and

wherein said data fields comprise a first program chain for storing a selected recording title, a user-assigned password for said selected recording title and a password menu screen for said selected recording title, said password menu screen prompting said user to input said user-assigned password if playback of said selected recording title is attempted, said first program chain being a single program chain according to DVD specifications.

17. The digital storage device of claim 16, wherein said digital storage device is a DVD.

18. The digital storage device of claim 16, wherein said first program chain also stores at least one command created in response to an input defining said user-assigned password.

19. The digital storage device of claim 16, wherein said password menu screen is created and stored in said first program chain in response to an input defining said user-assigned password.

20. The digital storage device of claim 18, wherein said at least one command causes said password menu screen to be displayed if playback of said selected recording title is attempted, and input of said user-assigned password is required before playing back said selected recording title.

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IX. Evidence Appendix

None.

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X. Related Proceedings Appendix

None.